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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,685	03/09/2000	David P. Maher	112770	1985
26652	7590	10/11/2005		
AT&T CORP. P.O. BOX 4110 MIDDLETOWN, NJ 07748			EXAMINER ABDI, KAMBIZ	
			ART UNIT 3621	PAPER NUMBER
DATE MAILED: 10/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/521,685

Applicant(s)

MAHER, DAVID P.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-53 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-53, 57-60 and 445 is/are rejected.
- 7) ☒ Claim(s) 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

2. The prior office action is incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- No claims have been amended.
- Claims 44-53 and 57-60 are pending.

Response to Arguments

3. Applicant's arguments filed 8 June 2005 have been fully considered but they are not persuasive for the following reasons:

4. Regarding the argument made by the applicant regarding the priority date and the qualification of the Fox published application and its provisional application (60/039,176) dated 10/01/1997, the examiner has reviewed the provisional application as well as the Fox published application and has concluded that the argument put forward by the applicant is in err. Referencing the applicant's argument that Fox provisional does not contain the support for published Fox ('174) paragraphs [0009], [0142] and [0144] is not correct. Examiner would like to point out that the paragraph [0009] in question is part of the summary of the invention that clearly is supported by the entire disclosure of the provisional application and clearly teaches the overall method and system of the Fox invention as a an electronic commerce transaction over an insecure network and no need for contacting the grantor for the acceptance of the transaction. Paragraph [0009] is clearly is supported by the disclosure of the Fox provisional that the signed certificate indicates that the first party agrees to make a payment for goods provided by the seller in an amount indicated in the certificate with out a need to contact a certification authority or the financial clearing-house at the time of the transaction. As for the paragraphs [0142] and [0144] they are supported as well by the page 7-11 as the description provided by the Fox provisional on the transaction protocol disclosure. Therefore the Fox published application ('174) is fully qualified as prior art in the 35 U.S.C. 103 rejections.

5. In addition based on further examination of claims 44 and 57 they would not be more than purchasing of an electronic money order or cashiers checks. A money order or cashiers check has a clear

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expiration date and an specific amount that the instruments valid for as they have been clearly described in the US Patent no. 6,070,150 to Remington et al and US Patent no. 5,677,955 to Doggett et al. Both describe a method of payment with certificates that have been issued with a specific time validation as well as amount (For example see Doggett figures 4 and 13 and column 8, line 60-column 9, line 62).

6. Therefore, the current examiner maintains the prior office action rejections mailed on 7 March 2005.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 44-53 and 57-60 are rejected under 35 U.S.C. 112 2nd paragraph.

9. The term "short-term" in claims 44 and 57 is a relative term which renders the claim indefinite.

The term "short-term" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

10. Claims 45-53 being dependent on independent claim 44 and claims 58-60 being dependent on independent claim 57 are rejected based on the above rational. Further clarification is required.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 44-47, 49, 57 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al, U.S. Patent Application Publication No. US 2002/0069174 A1 in view of Fox et al, U.S. Patent No. 5,790,677.

13. As per Claim 44, Fox et al ('174) disclose a method performed by a guarantor of payment for purchases comprising:

- receiving from a user a request to send to the user at least one short-term certificate, the request containing at least information that verifies the identity of the user (0009; 0073-0074; 0078; 0136; 0138);
- responsive to the request, and upon authenticating the user, determining a maximum amount during which said guarantor is willing to provide payment for purchases by the user (0009, 0014);
- sending to the user a short term certificate guaranteeing payment up to said maximum amount for a purchase by the user from a supplier in a transaction carried out over a network, so that use user is enabled to enter into a transaction using the short term certificate as a form of payment that will be accepted by the supplier (0009; 0016; 0079; 0139);
- receiving the short-term certificate from the supplier (0009; 0142; 0144);
- making payment to the supplier for the purchase a) without having received from the supplier any request for assurance relative to the short-term certificate or relative to the guarantor's guarantee to make the payment, and b) without providing any such assurance to the supplier (0009; 0142; 0144).

Although it is generally well known to include expiration information or validity periods in certificates, Fox et al ('174), however, fail to disclose this. Fox et al ('174) further fail to disclose receiving an electronic record of the transaction from the supplier. Fox et al ('677) disclose generating and sending credentials to consumers to be used during a transaction (Col. 11, lines 14-25; Col. 23, lines 10-55). Fox et al ('677) further disclose that the credential includes expiration information or a validity period (Col. 11, lines 15-23; Col. 23, lines 25-35 and 40-48). Fox et al ('677) further disclose that the purchaser creates a commerce document such as a purchase order (Col. 12, lines 50-57) and a commerce instrument such as a purchase instruction identifying a method of payment (Col. 25, lines 3-13) including

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the purchaser's credential and forwards this to the supplier in order to initiate a transaction. The supplier then forwards the purchase instruction (electronic record of the transaction) to the acquirer server in order to receive payment (Col. 25, lines 44-50). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Fox et al ('174) and include in the short term certificate expiration information or a validity period as taught by Fox et al ('677) in order to limit the timeframe in which the certificate is valid as is well known in the use of digital certificates. It also would have been obvious to modify the method of Fox et al ('174) and include sending an electronic record of the transaction to the guarantor so that the guarantor has a record of the transaction when paying the merchant.

14. As per Claim 47, Fox et al ('174) further disclose wherein the short term certificate further includes an assertion of at least one entitlement of the user in addition to the ability to use the short term certificate to pay for purchases (0009; 0014; 0017; 0166).

15. As per Claim 49, Asay et al further disclose wherein the short term certificate further includes an indication that the user is entitled to use a form of payment other than money such as a letter of credit (0017).

16. As per Claims 57 and 60, Fox et al ('174) disclose a method performed by a supplier of goods or services comprising:

- receiving short-term certificate from a customer that contains a maximum amount during which the guarantor is willing to guarantee payment for purchases by the customer (0009; 0016; 0089-0091; 0142-0144);
- consummating a purchase transaction with the customer over a network including acceptance of the short term certificate as payment for the purchase without seeking any assurances relative to the short term certificate or relative to the guarantor's guarantee to make the payment, other than any assurances contained in the short term certificate itself, (0009; 0016; 0089-0091; 0142-0144);

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- sending the short-term certificate to a billing system for payment from guarantor (0009; 0142; 0144);
- receiving the payment from the guarantor (0009; 0144).

Although it is generally well known to include expiration information or validity periods in certificates, Fox et al ('174), however, fail to disclose this. Fox et al ('174) further fail to disclose receiving an electronic record of the transaction from the supplier. Fox et al ('677) disclose generating and sending credentials to consumers to be used during a transaction (Col. 11, lines 14-25; Col. 23, lines 10-55). Fox et al ('677) further disclose that the credential includes expiration information or a validity period (Col. 11, lines 15-23; Col. 23, lines 25-35 and 40-48). Fox et al ('677) further disclose that the purchaser creates a commerce document such as a purchase order (Col. 12, lines 50-57) and a commerce instrument such as a purchase instruction identifying a method of payment (Col. 25, lines 3-13) including the purchaser's credential and forwards this to the supplier in order to initiate a transaction. The supplier then forwards the purchase instruction (electronic record of the transaction) to the acquirer server in order to receive payment (Col. 25, lines 44-50). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Fox et al ('174) and include in the short term certificate expiration information or a validity period as taught by Fox et al ('677) in order to limit the timeframe in which the certificate is valid as is well known in the use of digital certificates. It also would have been obvious to modify the method of Fox et al ('174) and include sending an electronic record of the transaction to the guarantor so that the guarantor has a record of the transaction when paying the merchant.

17. Claims 48, 50-53 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al, U.S. Patent Application Publication No. Us 2002/0069174 A1 and Fox et al, U.S. Patent No. 5,790,677 as applied above and further in view of Golden et al, U.S. Patent No. 5,761,648.

18. As per **Claims 48, 50-53 and 58-59**, Fox et al ('174) fail to explicitly disclose wherein the short term certificate contains information specifying consumer points, consumer marketing offers or purchase

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discounts. Golden et al disclose an interactive marketing network and process using electronic certificates and teach issuing electronic certificates to users that can be used for various purposes and include specifying coupons, discounted prices on a product or service, proof of a gift or award such as loyalty points, proof of payment or any other type of certificate or voucher (abstract, Col. 8, lines 10-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fox et al ('174) and Fox et al ('677) and allow for the specification of certain points, marketing offers or discounts in the certificate as taught by Golden et al. Golden et al provides motivation for providing these discounts in a certificate by indicating that this provides added efficiencies to companies merchandising products and services online (Col. 1, lines 10-63). Fox et al ('174) provides further motivation by indicating that the certificate may be used for shopping clubs wherein a member may purchase goods at the club (0166).

19. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Allowable Subject Matter

20. Claims 45-46 are objected to as being dependent upon a rejected base claim 44, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

21. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Sudia discloses a method for securely using digital signatures in a commercial cryptographic system and further teach a user long term basic certificate as well as a short term authorization certificate that specifies transaction amount limitations and time limits.
- Fox et al [US 2002/0069174] disclose a system for electronic commerce transactions and further teach sending a customer certificate to a bank for payment

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- Walker et al disclose a method for executing cryptographically enabled letters of credit

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

<http://portal.uspto.gov/external/portal/pair>

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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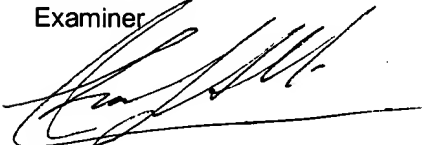
(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Examiner



October 3, 2005